

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendments, claims 13-21, 24-29, 31, and 33 are pending in the application, with claims 13, 24, 28, and 29 being the independent claims. Claims 24-27, 29, 31 and 33 have been withdrawn from consideration as being directed to a non-elected Group. Claims 13, 16, 17, and 28 are sought to be clarified. Claims 30 and 32 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Applicant reserves the right to prosecute similar or broad claims, with respect to any amended or cancelled claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

These amendments should be entered after final because they merely clarify the claims and because they merely reflect incorporation of subject matter already examined, e.g., from now cancelled claims 30 and 32, into respective independent claims 13 and 28. Thus, the amendments do not require further search or consideration, and place the application in condition for allowance or better condition for appeal. Further, as noted in FN1, claim 32 has not been properly examined.

Based on the above amendments and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Traversal of Restriction Requirement

The Examiner made a late allegation there should be two Groups of claims, Group I (13-21, 28, 30 and 32) and Group II (24-27, 29, 31 and 33), after each Group has already been examined at least two times. Applicant respectfully traverses.

Applicant does not believe the Examiner has adequately, under the law, provided a viable reason for restricting the claims at this stage of the prosecution, nor has the Examiner proved any burden of examining all the claims. In contrast, the Examiner has already examined claims 13-29 (for example, in the Non-Final Office Action dated January 5, 2010 and the Final Office Action dated September 30, 2009). Applicant respectfully requests more explicit reasoning than is provided in the Office Action as to

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why the Examiner believes he can now hold there are multiple patentably distinct Groups and that examination of these alleged Groups present a burden on the Examiner.

As noted in M.P.E.P Section 803 Restriction - When Proper (emphasis added):

...
If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

I. CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

II. GUIDELINES

...
For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04 - § 806.04(i) and § 808.01(a).

As shown, this Section explicitly states that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions” (emphasis added). As the Examiner has already examined all the claims, as noted above, the Examiner cannot now state there is a burden.

Notwithstanding the traversal, Applicant hereby provisionally elects to prosecute Group I, represented by claims 13-21 and 28 (as claims 30 and 32 are being cancelled herein). This election is made without prejudice to or disclaimer of the other claims

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disclosed. Furthermore, the claims are not intended to be limited by parts of the specification and figures corresponding to the elected Group.

As discussed above, this election is made with traverse.

Although Applicant has tentatively withdrawn claims 24-27, 29, 31 and 33, Applicant respectfully requests that the Examiner reconsider and withdraw the Restriction Requirement and continue examining all claims. Consideration and allowance of the pending claims are respectfully requested.

Rejections under 35 U.S.C. § 112

Claims 13-21, 28, 30 and 32 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant respectfully traverses.

Without conceding the propriety of the rejection, and for other reasons, claims 30 and 32 have been cancelled, rendering their rejection moot.

Without conceding the propriety of the rejection, and merely to expedite prosecution, based on the amendments above, Applicant respectfully requests the rejection of the pending claims be reconsidered and withdrawn.

Rejection under 35 U.S.C. § 103

Claims 13-21, 28, 30 and 32¹ are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,823,948 to Ross, Jr. et al. ("Ross") in view U.S. Pub. Pat. Appl. No. 2002/0082868 to Pories et al. ("Pories"), and in further view of "A Hierarchical Data Management Facility For Clinical Record Applications" ("NPL"). Without conceding the propriety of the rejection, and for other reasons, claims 30 and 32 have been cancelled, rendering their rejection moot. Applicant respectfully traverses the

¹ At pages 11-12 of the final Office Action, the Examiner states claim 33 is rejected. However, claim 33 has been withdrawn from consideration. Further, the Examiner provides no support for the rejection of claim 32 aside from the statement of rejection on page 5 of the final Office Action. Therefore, Applicant respectfully submits the Office Action is defective and requests the amendments be entered that application passed to issue, or a corrective, new Office Action be mailed addressing the examination of claim 32.

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rejection of the pending claims, and the Response to Arguments section at page 12 of the final Office Action.

Without conceding the propriety of the rejection, claims 13 and 28 have amended to clarify the distinguishing features.

For example, claims 13 and 28 recite, in part, “retrieving a concept that is similar or broader to the patient language symptom if the patient-language symptom does not exactly match the imparted concept identifier of the standard code.”

Ross discloses that “*The final diagnosis can be easily selected from the differential diagnosis. Trauma diagnosis can be selected from graphic presentations of the appropriate body parts. For example, a particular fractured bone and the fracture location, characteristics, and type can be indicated on a graphical display of the body part. TeleMed converts the fracture facts into proper medical English describing the injury.*” (See, e.g., Ross at Col. 13, lines 65-67 and Col. 14, lines 1-5). In contrast, the claims recite a differential diagnosis referring to a list of the most common *causes* of a given symptom, and not to a list of *disorders similar* to a given disorder as taught in Ross, or to such lists when they are annotated with advice on how to narrow the list down as is taught in Ross.

Therefore, Ross does not disclose “retrieving a *concept that is broader to the patient language symptom* if the patient language symptom does not match the imparted concept identifier of the standard code,” as recited in claims 13 and 28. The “concept that is broader to the patient language symptom” as recited in claims 13 and 28 distinguishes from the teachings in Ross, which relate to a final diagnosis, the differential diagnosis, the most common *cause* of a given symptom, or the disorder similar to a given disorder. The recited “concept that is broader to the patient language symptom,” as recited in claim 13 and 28, is not about a diagnosis, as taught in Ross, but about a symptom.

Ross simply discloses searching for other diagnosis having similar symptoms to a given diagnosis, but does not disclose the recited searching for the standard expression having the same (or broader) meaning as the patient language symptom.

Further, Ross does not teach or suggest *how* TeleMed converts the fracture facts into proper medical English describing the injury and *what* the proper medical English describing the injury is, as is recited in claims 13 and 28.

Further, Ross in view of NPL does not disclose the recited determining whether the patient language symptom matches the concept identifier of the standard code or not. Therefore, the NPL cannot be used to cure the deficiencies in Ross.

Pories is not used by the Examiner to disclose, nor does Pories teach or suggest, at least the above noted distinguishing features of claims 13 and 28. Therefore, as Pories cannot cure the deficiencies of Ross and the NPL, the applied references cannot be used to establish a prima facie case of obviousness.

Accordingly, Applicant respectfully requests that the rejection of claims 13 and 28 be reconsidered and withdrawn, and that these claims be passed to allowance. Also, at least based on their dependency to claim 13, claims 14-21 should be found allowable, as well as for their additional distinguishing features.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg
Attorney for Applicant
Registration No. 43,447

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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